

**REMARKS**

Claims 1, 2, 4, 5, 14 and 15 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Ogata in view of Kitagishi. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. MPEP § 2142.

Claims 1, 2, 4, 5, 14 and 15 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5, 721, 994 to Ogata et al. (Ogata) in view of U.S. Patent No. 5,140,462 to Kitagishi. Claims 3, 8-13, 16, 18 and 21 have been objected to as being dependent upon a rejected base claim.

The Examiner stated in paragraph 3 of the Office Action that “Ogata discloses a camera comprising correcting optics (13; see figure 1) disposed between a prism and an objective lens of a camera for compensating for spherical and coma aberrations (see col. 5 lines 50-55). Ogata discloses a single unit element and fails to specifically disclose at least two lenses makes up the correction unit.”

Claim 1 recites a corrector optic for being optically disposed between a prism and an objective lens of a camera, comprising at least two lenses for compensating spherical and coma aberrations generated by the prism.

First, Ogata does not disclose correcting optics disposed between a prism and an objective lens of a camera, as the Examiner maintains. The Examiner identifies main lens unit 13 as the correcting optic. If main lens 13 is the correcting optic, there is no prism evident in Ogata. The correcting optic must be “optically disposed between a prism and an objective lens of a camera.”

Second, the Examiner implies that main lens unit 13 is a prism. Ogata discloses that “The main lens unit 13 used in the first embodiment is a prism-shaped lens unit which has a reflecting surface 13a”. The relevant distinction within the context of the invention is the optical interpretation of “prism.” The prism in the application is a “plano optic” element, through which light enters and leaves via parallel plane faces, or optically-parallel plane faces separated by a plane reflecting surface. Ogata’s prism-shaped lens is a lens, in that it has curved faces through which light enters and leaves, and is described by Ogata as prism-shaped only because it includes a plane-reflecting surface.

This use of the term “prism shaped” is non-standard, and not related to the optical imaging properties of prisms as discussed in the application. The optical imaging properties of both the prism-shaped lens and the prisms disclosed in the application are not affected by the plane reflecting surface, since there is no refraction there, and no associated aberrations. That is, the plane reflecting surfaces are quite irrelevant to what is optically a “prism.” Indeed, Ogata’s optical diagrams (Figs. 2A, 2B, and others) ignore the reflecting surface, since it has no affect on the optical imaging properties other than a

change of direction of the optical axis. In an optical sense as consistently used in the application, Ogata's system has no prism.

Those of ordinary skill in the art recognize that prisms, at the very least, do not have curved surfaces, hence main lens unit 13 is labeled as a prism-shaped lens, rather than a prism.

Kitagishi discloses a fixed first lens unit, a fixed second lens, and a variable vertical angle prism constituting part of image deflecting means between the first lens unit and the fixed second lens. Col. 4, lines 55-58, also see Figure 1. Kitagishi fails to teach or suggest a corrector optic for being optically disposed between a prism and an objective lens of a camera, as recited in claim 1. Rather, Kitagishi discloses the variable vertical angle prism between two lenses.

Finally, the Examiner has not established that there is a reasonable expectation of success in combining Ogata and Kitagishi.

The cited art fails to teach or suggest all the elements of claim 1 and the Examiner has not established that there is a reasonable expectation of success in combining Ogata and Kitagishi, therefore the Examiner has failed to establish a prima facie case of obviousness. If the Examiner maintains the rejection, Applicant respectfully requests that

the Examiner specifically address Applicant's remarks with respect to the prism-shaped lens of Ogata.

Claims 2, 4, 5, 14 and 15 also recite a corrector optic for being optically disposed between a prism and an objective lens of a camera. Therefore a prima facie case for obviousness has not been met with respect to claims 2, 4, 5, 14, and 15. Claims 1, 2, 4, 14, and 15 are in condition for allowance.

Claims 6 and 7 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Ogata in view of Kitagishi, further in view of U.S. Patent No. 6,157,781 to Kono et al. (Kono). Claims 6 and 7 depend from and include the limitations of claim 4. Kono fails to teach or suggest a corrector optic for being optically disposed between a prism and an objective lens of a camera. Finally, the Examiner has not established that there is a reasonable expectation of success in combining Ogata, Kitagishi, and Kono. A prima facie case for obviousness has not been met with respect to claims 6 and 7. Claims 6 and 7 are in condition for allowance.

Claim 17 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Ogata in view of Kitagishi, further in view of U.S. Patent No. 5,034,763 to Inabata. Claim 17 depends from and includes the limitations of claim 14. Inabata fails to teach or suggest a corrector optic for being optically disposed between a prism and an objective lens of a camera. Finally, the Examiner has not established that there is a reasonable

expectation of success in combining Ogata, Kitagishi, and Inabata. A prima facie case for obviousness has not been met with respect to claim 17. Claim 17 is in condition for allowance.

Claims 19 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Ogata. Claim 19 recites a corrector-optic module for coupling between an objective lens and a prism module. Although the language for claim 19 is not identical to the language for claim 1, the same argument applied to claim 1 applies to claim 19. A prima facie case for obviousness has not been met with respect to claim 19. Claim 19 is in condition for allowance.

Claim 20 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Ogata in view of Kitagishi. Claim 20 depends from and includes the limitations of claim 19. Kitagishi fails to teach or suggest a corrector-optic module for coupling between an objective lens and a prism module. Finally, the Examiner has not established that there is a reasonable expectation of success in combining Ogata and Kitagishi. A prima facie case for obviousness has not been met with respect to claim 20. Claim 20 is in condition for allowance.

Applicant respectfully requests that the Examiner allow all the claims and direct the application to issue.

In view of the foregoing, consideration and an early allowance of this application  
are earnestly solicited.

Respectfully submitted,  
Sierra Patent Group, Ltd.

A handwritten signature in black ink, appearing to read 'Kenneth D'Alessandro', with a long horizontal flourish extending to the right.

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